



GREENBLUM & BERNSTEIN, P.L.C.
Intellectual Property Causes
 1941 Roland Clarke Place
 Reston, VA 20191
 (703) 716-1191

3742

Attorney Docket No. P18520

In re application of : Masakazu FURUKAWA et al.

Box Non-Fee

Serial No. : 09/462,067

Group Art Unit : 3742

Filed : January 5, 2000

Examiner : S. Paik

For : CERAMIC HEATER AND METHOD OF PRODUCING THE SAME AND ELECTRICALLY
 CONDUCTIVE PASTE FOR HEATING BODY

THE COMMISSIONER OF PATENTS AND TRADEMARKS
 Washington, D.C. 20231

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APR 13 2001

TECHNOLOGY CENTER R3700

Sir:

Transmitted herewith is an Election with Traverse in the above-captioned application.

- ☐ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a verified statement previously filed.
- ☐ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.
- ☐ An Information Disclosure Statement, PTO Form 1449, and references cited.
- ☒ No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 24	*20	0	x 9=	\$	x 18=	\$0.00
Indep. Claims: 6	**6	0	x 40=	\$	x 80=	\$0.00
Multiple Dependent Claims Presented			+135=	\$	+270=	\$0.00
Extension Fees for Month				\$		\$0.00
Total:				\$	Total:	\$0.00

*If less than 20, write 20

**If less than 3, write 3

☐ Please charge my Deposit Account No. 19-0089 in the amount of \$_____.☒ A Check in the amount of \$_____ to cover the filing/extension fee is included.☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.☒ Any additional filing fees required under 37 C.F.R. 1.16.☒ Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 CFR 1.136)(a)(3).

Bruce H. Bernstein
 Bruce H. Bernstein
 Reg. No. 29,027

Pg. 45,305

P18520.A04



4-16-01
#7

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Masakazu FURUKAWA et al.

Art Unit 3742

Appl. No.: 09/462,067 (National Stage of
PCT/JP99/03086)

Examiner: S. Paik

Intl Appl. Filed: June 9, 1999

U.S. Appl. Filed: January 5, 2000

For: CERAMIC HEATER AND METHOD OF PRODUCING THE SAME AND
ELECTRICALLY CONDUCTIVE PASTE FOR HEATING BODY

ELECTION WITH TRAVERSE

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

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TECHNOLOGY CENTER R3700

This paper is responsive to the Restriction Requirement mailed March 12, 2001, the time set for response being one month from the mailing date from the U.S. Patent and Trademark Office, i.e., April 12, 2001.

Inasmuch as this response is being filed by the initial due date, no extension of time is believed to be necessary. However, if any extensions of time are necessary, the Commissioner is hereby authorized to charge any necessary fees, such as any necessary extension of time fees, to deposit account No. 19-0089.

ELECTION WITH TRAVERSE

Applicants elect, with traverse, the invention defined by Group I (claims 1-13) and the species of Fig. 2. Applicants also submit that at least claims 1-13 are readable on the elected species.

In the Official Action of March 12, 2001, the Examiner indicated that all claims (1 to 24) were subject to restriction under 35 U.S.C. § 121.

The Examiner has required restriction to one of the following inventions under 35 U.S.C. 121:

- I. Claims 1-13, drawn to a ceramic heater, classified in class 219, subclass 444.1;
- II. Claims 14-18, drawn to a method of making a heater, classified in class 29, subclass 611; and
- III. Claims 19-24, drawn to a conductive paste, classified in class 219, subclass 543.

The Examiner asserts that the inventions are patentably distinct, each from the other, for the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the Examiner states that the product can be made by materially different process where the heating body can be provided by arranging a heating wire rather than printing such element on the ceramic body.

Inventions III and I are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the Examiner states that the intermediate product is deemed to be useful as a thermally conductive element, and that the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. The

Examiner states that if applicants traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case and that if the Examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection.

The Examiner contends that these inventions are distinct for the reasons given above, and have acquired a separate status in the art as shown by their different classification.

The Examiner also requires that applicants also make an election of patentably distinct species. The Examiner notes that the application contains claims directed to the following patentably distinct species: Fig 2; Fig. 3; Fig 5a-5d; and Fig. 6a and 6b. The Examiner requires that applicants elect a single disclosed species for prosecution on the merits and list all claims readable thereon, including any claims subsequently added. The Examiner further states that upon allowance of a generic claim, applicants will be entitled to additional species claims which are written in dependent form and otherwise include all the limitations of an allowed generic claim.

First, Applicants respectfully submit that the Examiner has omitted one of the two criteria for a proper restriction requirement now established by the U.S. Patent and Trademark Office policy. That is, as set forth in MPEP § 803, "an appropriate explanation" must be advanced by the Examiner as to the existence of a "serious burden" if the restriction requirement were not required.

While the Examiner has alleged a possible distinction between the three identified groups of invention, the Examiner has not shown that a concurrent examination of these groups would present a "serious burden" on the Examiner. In fact, while the Examiner has noted that the individual groups would be classified in different classes, there is no appropriate statement that the

search areas required to examine the invention of Group I would not overlap into the search areas for examining the invention of Groups II and III, and vice versa. Applicants respectfully submit that the search for the combination of features recited in the claims of the above-noted groups, if not totally co-extensive, would appear to have a very substantial degree of overlap. Because the search for each group of invention is substantially the same, Applicants submit that no undue or serious burden would be present in concurrently examining Groups I to III. Thus, for the above-noted reasons, and consistent with the office policy set forth above in MPEP § 803, Applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement in this application.

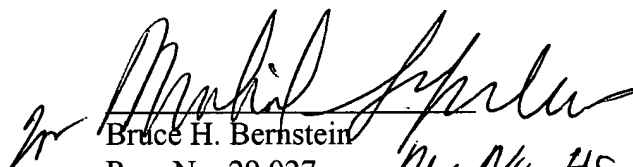
Applicants also have elected the species of Fig. 2, upon which claims 1-13 are readable. This election is without traverse to the extent that it is understood that (a) the requirement will be withdrawn upon the finding of an allowable genus; and (b) any species withdrawn from consideration will be transferred to the elected subject matter unless it is found patentably distinct from the elected or allowed claims.

CONCLUSION

For all of the above reasons, the Examiner's restriction is believed to be improper. Nevertheless, Applicants have elected, with traverse, the invention defined by Group I (claims 1-13) with the ultimate species being Fig. 2, in the event that the Examiner chooses not to reconsider and withdraw the restriction requirement. Applicants submit that claims 1-13 read upon the elected species.

If the Examiner has any questions, or wishes to discuss this matter, please call the undersigned at the telephone number indicated below.

Respectfully submitted,
Masakazu FURUKAWA, et al.


Bruce H. Bernstein
Reg. No. 29,027 *Reg No. 45,305*

April 2, 2001
GREENBLUM & BERNSTEIN, P.L.C.
1941 Roland Clarke Place
Reston, VA 20191
(703) 716-1191